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10/807,396

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Jeffry B. Skiba

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EXAMINER

WOO, JULIAN W

ART UNIT

PAPER NUMBER

3731

MAIL DATE

DELIVERY MODE

05/07/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/807,396

Applicant(s)

SKIBA ET AL.

Examiner

Julian W. Woo

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 and 51-56 is/are pending in the application.
- 4a) Of the above claim(s) 8, 10, 11, 14, 15, 19, 20, 25, 26, 30, 32-36, and 51-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 12, 13, 16-18, 21-24, 27-29, 31, 55 and 56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/24/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of claims 1-9, 12, 13, 16-18, and 22, directed to species 1 of Group I and shown in Fig. 1, in the reply filed on March 27, 2007 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Upon further consideration of this election, the Examiner has rejoined claims 23, 24, 27-29, 31, 55, and 56 (as also readable on the design of Fig. 1) and withdrawn claim 8 from the Applicant's election. In short, claims 1-7, 9, 12, 13, 16-18, 21-24, 27-29, 31, 55, and 56 are elected for prosecution on the merits.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 24 and 27-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not certain how the "distal end" of the shaft is angularly bent, curved at least partially about, is extended at an angle and to one side of, and is extended at least partially forward from "said shaft," "the distal end of the shaft," or "the distal end" (i.e., itself).

### ***Claim Rejections - 35 USC § 102***

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 6, 7, 9, 12, 13, 16-18, 21-24, 27-29, 31, 55, and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by Mollenauer et al. (5,562,685).

Mollenauer et al. disclose, at least in figures 1 and 12 and in col. 9, line 37 to col. 10, line 5; a suturing device including a handle (102 or 12), an elongated shaft (104 or 102) with a distal end, a sharpened tip (106 or 104) or detachable needle, and a detachable suture (110) that is a length of material; where the sharpened tip (106) includes an elongated opening (108) configured to trap a suture at a selected point and including a curved portion, where the sharpened tip (104) has a hooked configuration or is angularly bent relative to the shaft in a selected direction, where the sharpened tip is curved at least partially about the distal end of the shaft (102) or extends at an angle and to one side of the distal end, where the sharpened tip (104) extends at least partially forward from the distal end with a concave configuration, and where the sharpened tip (106) is selectively detachable from the shaft (104).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mollenauer et al. (5,562,685) in view of Zocher (3,645,222). Mollenauer et al. disclose the invention substantially as claimed, but do not disclose a sharpened tip including an opening with at least a portion dimensioned to wedge and hold a suture, having a central portion with a tapered configuration, or comprising a tapered opening. Zocher teaches, at least in figures 1, 2, 6, and 7 and in col. 1, lines 52-57; a device with a sharpened tip including an opening (15) with at least a portion dimensioned to wedge and hold a suture, having a central portion with a tapered configuration, or comprising a tapered opening. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the opening of the device of Mollenauer et al., so that it has the tapered configuration as taught by Zocher. Such an opening would enhance the trapping of a suture at a selected point, so that a user can manipulate the suture and sharpened tip with better control during suturing (i.e., the suture would less likely move inadvertently in an opening as taught by Zocher).

### **Conclusion**

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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Edwards (818,152), Drake & Dodd (919,138), and Biro (1,583,271) teach suturing devices.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian W. Woo whose telephone number is (571) 272-4707. The examiner can normally be reached Mon.-Fri., 7:00 AM to 3:00 PM Eastern Time, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Julian W. Woo  
Primary Examiner

April 26, 2007